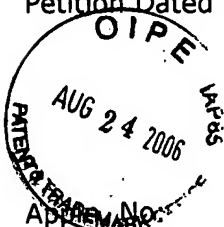


Appln. No.: 10/616,274  
Petition Dated August 21, 2006

BSI-210US5



Appl. No.: 10/616,274  
Applicant: George Goicoechea et al.  
Filed: 07/09/2003  
Title: BIFURCATED ENDOLUMINAL PROSTHESIS  
TC/A.U.: 3738  
Examiner: Javier G Blanco  
Confirmation No.: 1706  
Docket No.: BSI-210US5

**PETITION FOR SUSPENSION OF ACTION FOR SIX MONTHS  
FOR GOOD AND SUFFICIENT CAUSE PURSUANT TO 37 C.F.R. § 1.103(a)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants request the PTO to suspend action of this application for six months for good and sufficient cause pursuant to 37 C.F.R. § 1.103(a) for the following reasons.

Claims 54-73 are pending in this application and have been allowed. Claims 54-60 were substantially copied from U.S. Patent No. 6,416,542 which issued to Marcade et al. on July 9, 2002.

On February 22, 2006, the PTO informed Applicants that claims 54-73 had been allowed, invited Applicants to suggest an interference under 37 C.F.R. § 41.202(a), and closed prosecution on the merits in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Concurrently with the filing of the present Petition, Applicants have filed papers with the PTO that comply with the request to suggest an interference under 37 C.F.R. § 41.202(a). Applicants have also concurrently filed a Request for Continued Examination (RCE) along with an Information Disclosure Statement (IDS) and a request for suspension for three months pursuant to 37 C.F.R. § 1.103(c). The request for a three month suspension has been filed in case the present Petition for a six month suspension is denied. If this Petition is granted, Applicants request that the Order granting the Petition state the specific date when the six

month period (or whatever period is granted) will end in order to avoid any confusion that might result from the prior grant of a three month suspension pursuant to § 1.103(c).

The present application is a continuation application of Application No. 08/463,987, which is a division of Application No. 08/317,763, now U.S. Patent No. 5,609,627. On October 22, 2001, an assignment of the '627 patent to Scimed Life Systems, Inc. was recorded at reel/frame 012520/0229. An assignment recorded against an original application is applied to a division or continuation application. MPEP § 306. Therefore, the present application is currently assigned to Scimed Life Systems, Inc., a company that was renamed Boston Scientific Scimed, Inc. ("Boston Scientific").

The face of the Marcade '542 patent indicates that it is assigned to Endovascular Technologies, Inc. Endovascular Technologies, Inc. is a subsidiary of Guidant Corporation, and Guidant is the owner of the '542 patent. On April 21, 2006, Guidant merged with Boston Scientific. Since the Marcade '542 patent is now owned by Boston Scientific or its affiliates, a declaration of an interference may not be appropriate in accordance with 37 C.F.R. § 41.206 and MPEP 2304.05. According to the MPEP, after a merger of two corporations,

the resulting corporation owns both applications. The new corporation is obligated to investigate priority. Once the corporation has had an opportunity to determine which application is entitled to priority, the corporation must elect between the applications or otherwise eliminate the need for an interference.

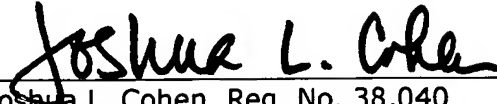
Boston Scientific has not yet been able to investigate priority between the present application and the Marcade '542 patent. The six month statutory deadline for response to the February 22, 2006 Office Action is August 22, 2006. Accordingly, Applicants request the PTO to suspend prosecution of this application for six months to enable Boston Scientific to investigate priority between the present application and the Marcade '542 patent.

Applicants submit that the above information provides good and sufficient cause for the PTO to suspend action in this application for six months, which action is requested. In addition to providing good and sufficient cause, Applicants have also

- Paid the fee required by 37 C.F.R. § 1.17(g) for the filing of this Petition;
- Submitted a reply to the outstanding Office Action by filing a suggestion for interference under 37 C.F.R. § 41.202(a);

- Paid the fee for a four month extension of time to respond to the outstanding Office Action

Respectfully submitted,



Joshua L. Cohen, Reg. No. 38,040  
Stanley Weinberg, Reg. No. 25,276  
Attorneys for Applicants

SW/dhm

Dated: August 21, 2006

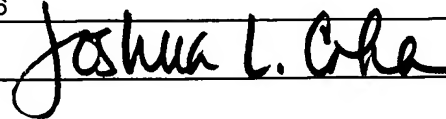
☒ P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

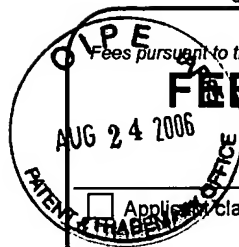
☐ P.O. Box 1596  
Wilmington, DE 19899  
(302) 778-2500

The Director is hereby authorized to charge or credit Deposit Account No. **18-0350** for any additional fees, or any underpayment or credit for overpayment in connection herewith.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

August 21, 2006





Effective on 12/08/04.

Fees pursuant to the Consolidated Appropriations Act. 2005 (H.R. 4818).

# **FREE TRANSMITTAL** **For FY 2006**

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

200.00

**Complete if Known**

Application Number	10/616,274
Filing Date	07/09/2003
First Named Inventor	George Goicoechea
Examiner Name	Javier G Blanco
Art Unit	3738
Attorney Docket No.	BSI-210US5

**METHOD OF PAYMENT** (check all that apply)
☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 18-0350 Deposit Account Name: RatnerPrestia

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Small Entity		Small Entity		Small Entity		
	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Small Entity	
Fee (\$)	Fee (\$)
50	25
200	100
360	180

<b>Total Claims</b>	<b>- 20 or HP =</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>	<b>Multiple Dependent Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
		x	=				

HP = highest number of total claims paid for, if greater than 20

<b>Indep. Claims</b>	<b>- 3 or HP =</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
		x	=	

HP = highest number of independent claims paid for, if greater than 3

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 100 =	/ 50 =	(round up to a whole number)	x	=

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Suspension Fee Under 37 CFR § 1.17(g)**Fees Paid (\$)**

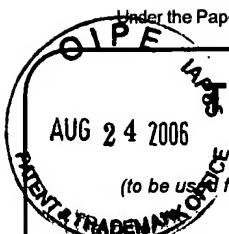
200.00

**SUBMITTED BY****Complete (if applicable)**

Signature <u>Joshua L. Cohen</u>	Registration No. Attorney/Agent	38,040	Telephone	610-407-0700
Name (Print/Type) Joshua L. Cohen	Date	8/21/2006		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

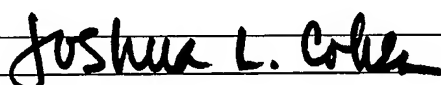
Application Number	10/616,274
Filing Date	07/09/2003
First Named Inventor	George Goicoechea et al.
Art Unit	3738
Examiner Name	Javier G. Blanco
Attorney Docket No.	BSI-210US5

## ENCLOSURES (Check all that apply)

- |   |   |   |
|---|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/Declaration(s)<br><br><input type="checkbox"/> Extension of Time Request<br><br><input type="checkbox"/> Express Abandonment Request<br><br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><br><input type="checkbox"/> Response to Missing Parts/<br>Incomplete Application<br><input type="checkbox"/> Response to Missing Parts<br>under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><br><input type="checkbox"/> Licensing-related Papers<br><br><input checked="" type="checkbox"/> Petition<br><br><input type="checkbox"/> Petition to Convert to a<br>Provisional Application<br><br><input type="checkbox"/> Power of Attorney, Revocation,<br>Change of Correspondence<br>Address<br><br><input type="checkbox"/> Terminal Disclaimer<br><br><input type="checkbox"/> Request for Refund<br><br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication<br>to TC<br><br><input type="checkbox"/> Appeal Communication to Board<br>of Appeals and Interferences<br><br><input type="checkbox"/> Appeal Communication to TC<br>(Appeal Notice, Brief, Reply<br>Brief)<br><br><input type="checkbox"/> Proprietary Information<br><br><input type="checkbox"/> Status Letter<br><br><input checked="" type="checkbox"/> Other Enclosure(s) (please<br>identify below): Credit Card<br>Payment Form; post card receipt |
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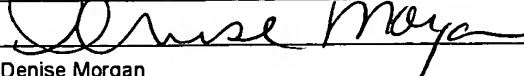
Remarks:

## SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm Name	RatnerPrestia		
Signature			
Printed Name	Joshua L. Cohen		
Date	8/21/2006	Registration No.	38,040

## CERTIFICATE OF TRANSMISSION / MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or Printed Name	Denise Morgan	Date	8/21/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Office, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.

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